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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,397	09/18/2001	Jaime A. Siegel	SNY-R4757	1207
24337 7590 02/18/2010 MILLER PATENT SERVICES 2500 DOCKERY LANE RALEIGH, NC 27606				
EXAMINER WINTER, JOHN M				
ART UNIT 3685		PAPER NUMBER		
MAIL DATE 02/18/2010		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/955,397

**Applicant(s)**

SIEGEL ET AL.

**Examiner**

JOHN M. WINTER

**Art Unit**

3685

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 106-118 and 121 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 106-118 and 121 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

1. The Applicants amendment filed on October 20, 2009 is hereby acknowledged, Claims 106-118 and 121 remain pending.

### ***Response to Arguments***

2. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 106-118 and 121 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.
4. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for

example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, claims 106, 116 and 121 fail prong (1) because the “tie” (e.g. electronic commerce computer system ) is representative of extra-solution activity.

Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

Claims 107-115, and 117 are either dependant upon claim 106 and 116 respectively and a rejected for at least the same reasons.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 106-118 and 121 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an e-commerce server (page 4, line 23 of specification filed 9/18/2001), does not reasonably provide enablement for the claimed element of "an electronic commerce computer system" as claimed in claims 106, 116 and 121. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Claims 107-115, and 117 are either dependant upon claim 106 and 116 respectively and are rejected for at least the same reasons.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 106-118 and 121 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle (US Patent 5,530,754 in view of Stefik (US Patent 5,715,403) and further in view of Walker et al. (US Patent 6,131,086).

8. As per claims 106, 116 and 121

Garfinkle ('754) discloses a method of delivering digital content, comprising:  
at an electronic commerce computer system, receiving a request from a customer for transfer of A/V content in digital form to the customer at a customer storage or playback device; at the electronic commerce computer system, receiving payment from the customer for the transfer of the A/V content in accordance with a first usage rule; transferring audio/video (A/V) content in digital form from a content provider to the customer in accordance with the first usage rule, the digital form of the A/V content comprising at least an audio portion and a video portion;(Column 3, lines 19-43; and Column 3 line 54 -- column 4 line 11; Figure 5)

at the electronic commerce computer system, receiving a request from the customer for acquisition of the additional usage fights beyond the first usage rights to the selected portions of the A/V content as a separate subsequent transaction;(Column 3, lines 19-43; and Column 3 line 54 -- column 4 line 11; Figure 5).

Garfinkle ('754) does not explicitly disclose presenting the A/V content to the customer for display on an entertainment system; displaying a menu on the entertainment system display just before, after or during presentation of the selection of A/V content to the customer, the menu displaying selected portions of the A/V content for which additional usage rights beyond said limited usage fights under the first Image rule that are available, at the electronic commerce computer system, receiving payment from the customer for the separate subsequent transaction; and as a result of receiving payment for said separate subsequent transaction, sending a key code to the user from the electronic commerce computer system that permits the user to extract and store the selected portion of the A/V

content under said separate usage rights beyond the first usage rule acquired as a result of the separate subsequent transaction on the customer storage or playback device. Walker et al. ('086) discloses presenting the A/V content to the customer for display on an entertainment system; (Column 3, lines 6-15) displaying a menu on the entertainment system display just before, after or during presentation of the selection of A/V content to the customer, (Column 7, lines 45-57; column 8, lines 54-64) the menu displaying selected portions of the A/V content for which additional usage rights beyond said limited usage fights under the first Image rule that are available, (column 8, lines 54 – column 9, line 7). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Garfinkle ('754) method with Walker et al's ('086)'s teaching in order to consumers to purchase content associated with the programming.

Garfinkle ('754) does not explicitly disclose providing limited usage rights to the A/V content to the customer; at the electronic commerce computer system, receiving payment from the customer for the separate subsequent transaction; and as a result of receiving payment for said separate subsequent transaction, sending a key code to the user from the electronic commerce computer system that permits the user to extract and store the selected portion of the A/V content under said separate usage rights beyond the first usage rule acquired as a result of the separate subsequent transaction on the customer storage or playback device. Stefik ('403) discloses providing limited usage rights to the A/V content to the customer (column 11, lines 42-63); at the electronic commerce computer system, receiving payment from the customer for the separate subsequent

transaction; column 29, line59 – column 30 line 32) and as a result of receiving payment for said separate subsequent transaction, sending a key code to the user from the electronic commerce computer system that permits the user to extract and store the selected portion of the A/V content under said separate usage rights beyond the first usage rule acquired as a result of the separate subsequent transaction on the customer storage or playback device. (column 36, lines 31-63, - Examiner notes that the claimed language “that permits the user to extract and store the selected portion of the A/V content under said separate usage rights beyond the first usage rule acquired as a result of the separate subsequent transaction on the customer storage or playback device” is representative of non-functional descriptive information and it has been held such information will not distinguish a claimed device from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01) ). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Garfinkle ('754)method with the Stefik ('403) method in order to control the use and distribution of digital information.

In regard to claim 116, Garfinkle ('754) discloses the A/V content further comprising a table of contents portion (TOC) that indexes the selected portion; (Column 3, lines 32-49)

9. As per claim 107,

Garfinkle ('754) discloses the method according to claim 106,

Garfinkle ('754) discloses the claimed invention except for “second



usage rule “. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a second usage rule, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

10. As per claim 108,  
Garfinkle ('754) discloses the method according to claim 107,  
where the separate subsequent transaction comprises one of: a purchase of unlimited rights to play the selected portion, a purchase of rights to play the selected portion for a designated period of time, and a purchase of rights to play the selected portion a designated number of times. (Column 3, lines 19-43; and lines 54-63)

11. As per claim 109,  
Garfinkle ('754) discloses the method according to claim 108,  
where the A/V content further comprises a table of contents portion (TOC) that indexes the selected portion.(Column 3, lines 54-62)

12. As per claim 110,  
Garfinkle ('754) discloses the method according to claim 106,  
Garfinkle ('754) does not explicitly disclose the presenting and enabling take place within a designated period of time defined by the first usage rule. Stefik ('403) discloses the presenting and enabling take place within a designated period of time defined by the

first usage rule (Figure 15). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Garfinkle ('754) method with the Stefik ('403) method since the combination of these elements does not alter their respective functions, the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention..

13. As per claims 111 and 117,  
Garfinkle ('754) discloses the method according to claim 106,  
where the A/V content comprises one of a motion picture, a television program, a  
documentary and a music video. (Abstract)

14. As per claim 112 and 118,  
Garfinkle ('754) discloses the method according to claim 106,  
where the transferring comprises one of downloading the A/V content as one or more  
digital files, streaming the A/V content, and transmitting the A/V content as a real time  
transmission.  
wherein the transferring comprises one of downloading the A/V content as one or more.  
(Abstract, Figure 5)

15. As per claim 114,  
Garfinkle ('754) discloses the method according to claim 106,

Garfinkle ('754) does not explicitly disclose where the storing comprises receiving a key code from the content provider to permit storing the selected portion. Stefik ('403) discloses where the storing comprises receiving a key code from the content provider to permit storing the selected portion (column 36, lines 31-63). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Garfinkle ('754) method with the Stefik ('403) method in order to control the use and distribution of digital information.

16. As per claim 114,  
Garfinkle ('754) discloses the method according to claim 106,  
where the storing comprises receiving a download from the content provider.  
(Abstract)

17. As per claim 115,  
Garfinkle ('754) discloses the method according to claim 106,  
Wherein the transferring is carried out on an electronic commerce server.(Abstract)

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3685

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685